

REMARKS

In the non-final Office Action mailed 10 March 2009, the Examiner stated that a Restriction was required for either 1) Group I, claims 1-34, drawn to compositions of formula I or 2) Group II, claims 35-48, drawn to methods of using the compounds of formula I.

Applicant elects Group I, claims 1-34 with traverse. Applicant traverses the requirement for restriction because once the compound claims are found patentable most and perhaps all of the method of use claims must also be patentable. If the compounds have not been made and used previous to this invention then all disclosed uses should be patentable and all the method claims should be allowed. There would be no additional burden on, or searches required by, the Examiner. Applicant traverses the restriction requirement and asks that it be reconsidered or at a minimum delayed until after the compound claims have been considered. Should the restriction requirement be maintained, Applicant asks that any and all appropriate method claims be rejoined upon allowance of any compound claims. Currently no amendments are needed for rejoinder of all the claims.

The Examiner also asked the Applicant to elect a single species. The Examiner stated that claims 30-32 were drawn to various species and that no single technical feature was involved such that there was, "no technical relationship involving a 'special technical feature' that can be established among the substituents." It was further stated in item 2 of the Office Action that the application contains more than one species of the generic invention as also disclosed in claims 32-34. The Office said these species lacked unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 and 13.2.

Applicant traverses the assertion of lack of unity of invention. Applicant agrees that more than one species are disclosed by the application. This is proper and typical for chemical inventions. Formula I of claim 1 clearly establishes the common technical relationship among all the compounds claimed by the application. In claim 1, formula I discloses a chemical nucleus which is the special common technical feature of this

invention. All the compounds claimed have in common the features described by Formula I, and all of its variables are clearly defined.

PCT Rules 13.1, 13.2 and 13.3.

13.1 – Requirement. The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”).

13.2 – Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled. Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

13.3 – Determination of Unity of Invention not Affected by Manner of Claiming. The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Applicant’s technical feature of Formula I, with its defined variables, satisfies the requirements of PCT Rules 13.1 and 13.2. This is further demonstrated by 37 CFR § 1.141(a) which reads as follows: “(a) Two or more independent and distinct inventions may not be claimed in one national application, *except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.*” (emphasis added)

The Application considered here currently has 29 generic compound claims. These generic claims each define a different set of allowable species. Each generic claim includes a common special technical feature, defined by Formula I of claim 1. As noted in PCT Rule 13. 2, "The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." Here each and every claim are united by a common feature, as described above, (the chemical nucleus as shown by Formula I). This common special technical feature is believed patentable over the prior art, thus the claims meet the requirements imposed by PCT Rules 13.1 and 13.2.

Applicant acknowledges the right of the Examiner to require a provisional election of a single species prior to examination on the merits, however, following election, the Markush-type claims should be examined fully with respect to the elected species and further to the extent necessary to determine patentability. See MPEP section 806.04 and reference to 37 CRF 1.146, Election of species, and related sections. "In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. " MPEP section 806.04 and reference to 37 CRF 1.146. Thus the rules require that each generic claim be fully considered after election of a species, in reverse numeric order, i.e. 32, 31, 30, 25, etc., until all claims are allowed or until it is determined that a genus claim is not allowable.

Applicant provisionally elects the following species.

N-cyclopropyl-4-(2-(6-methylpyridin-2-yl)imidazo[1,2-a]pyridin-3-yl)pyrimidin-2-amine.

The structure is provided on the page below, where R= cyclopropyl.
(Remainder of this page is blank.)

/

/

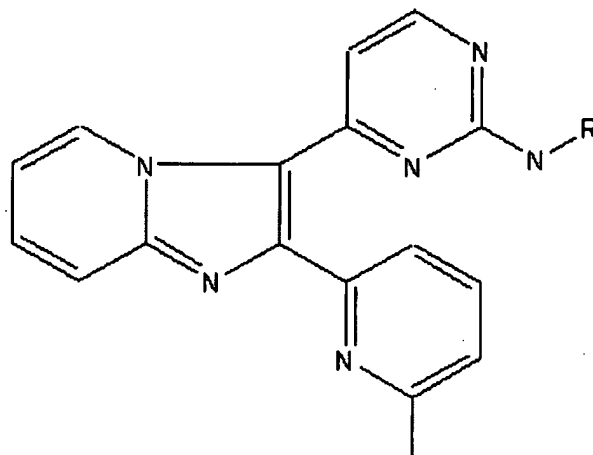
/

/

/

/

/



(R= cyclopropyl)

This species can be found in the following restricted Group I set of pending claims.

Claim 1, 2, 3, 4, 5, 6, -, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, -, -, -, -, 30, 31, 32, 33, and 34. It is also referenced in corresponding method claims.

In claims 30, 31, and 32, the name of the provisionally elected compound is spelled as follows:

Cyclopropyl-{4-[2-(6-methyl-pyridin-2-yl)-imidazol[1,2-a]pyridin-3-yl]-pyrimidin-2-yl}-amine

Conclusion

For all of the reasons above, Applicant looks forward to a full examination of all the claims on the merits and an early allowance thereof.

PETITION FOR AN EXTENSION OF TIME UNDER 37 CFR § 1.17


This is a response to an Office Action mailed on March 10, 2009. Applicants petition for an extension of two months of time under 37 C.F.R. § 1.17 and request that

charges be taken from Deposit Account No 503145, referencing attorney docket number 223255/A166US/121058.

Should any additional charges or credits required in order to continue prosecution, please apply them from Deposit Account No 503145, referencing attorney docket number 223255/A166-US/121058 and advise me of the charge immediately.

Respectfully submitted,

Date: June 9, 2009

A handwritten signature in dark ink, appearing to read "Thomas A. Wootton", is written over a horizontal line.

Thomas A. Wootton
Reg. No. 35004
Honigman Miller Schwartz and Cohn LLP
444 West Michigan Avenue
Kalamazoo, MI 49007
Telephone: (269) 337-7838
Facsimile: (269) 337-7839

KALAMAZOO.16391.1